

Serial No.: 10/789,063
Group Art Unit No.: 1624

I. The Restriction Requirement Under 35 U.S.C. §121

The Examiner has required restriction of the claims to one of the following categories:

Group I: Claims 1-12, 13 and 15-18, drawn to compounds of formula I;

Group II: Claims 19-25, drawn to various methods of use; and

Group III: Claim 34, drawn to a process of making a compound of formula I.

The Examiner maintains that the above grouping is proper, since the inventions listed in Groups I-III are distinct and have acquired a separate status in the art because of their divergent subject matter. Applicants respectfully traverse this rejection. However, in order to be completely responsive, Applicants hereby affirm their provisional election of Group I, Claims 1-12, 13 and 15-18, drawn to compounds of formula I, and further elect the species of Example 59, which is 4-[[N^a-(4-pyridinylmethoxycarbonyl)-L-leucinyl]amino]-1-(2-pyridylsulphonyl)-3-pyrrolidinone.

Applicants submit that the standard applicable to the instant application is not one of restriction practice under U.S. guidelines, but of unity of invention under the PCT. In the instant case, no lack of unity of invention was found by the International Searching Authority or the International Preliminary Examining Authority; all claims were searched and examined as one invention. Thus, the restriction requirement made according to U.S. practice is in error, since the question of unity of invention may be reexamined only within the scope of rules of the Patent Cooperation Treaty (35 U.S.C. § 372(b)). Patent Cooperation Treaty Article 27 states that "no national law shall require compliance with requirements relating to form or contents ... different from or additional to those which are provided for this Treaty and the Regulations". Therefore, the Examiner must find error in the way the rules were applied by the International Search Authority.

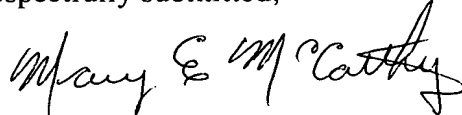
In the instant case, all of the compounds of formula (I) share a common operation, as found in their mechanism of action (inhibition of cysteine protease); and they share a common effect, which is the inhibition of bone loss. The compounds, methods of use and processes for preparing the compounds are so connected as to have arisen from a singular research effort. Thus, Applicants submit that the claims should not be restricted, and the inventions of groups I-III must be included in a single application. Therefore, the Examiner is respectfully requested to reconsider and withdraw his restriction requirement with respect to Groups I-III.

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This reply is intended to distinctly and specifically point out presumed errors in the Examiner's Action, to respond to every ground of objection and rejection, and to advance this case to allowance.

In view of the above remarks, reconsideration of this application is requested. Should the Examiner have any questions or wish to discuss any aspect of this case, the Examiner is encouraged to call the undersigned attorney at the number below.

Respectfully submitted,

A handwritten signature in cursive script, reading "Mary E. McCarthy". The signature is written in dark ink and is positioned above the printed name.

Mary E. McCarthy

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